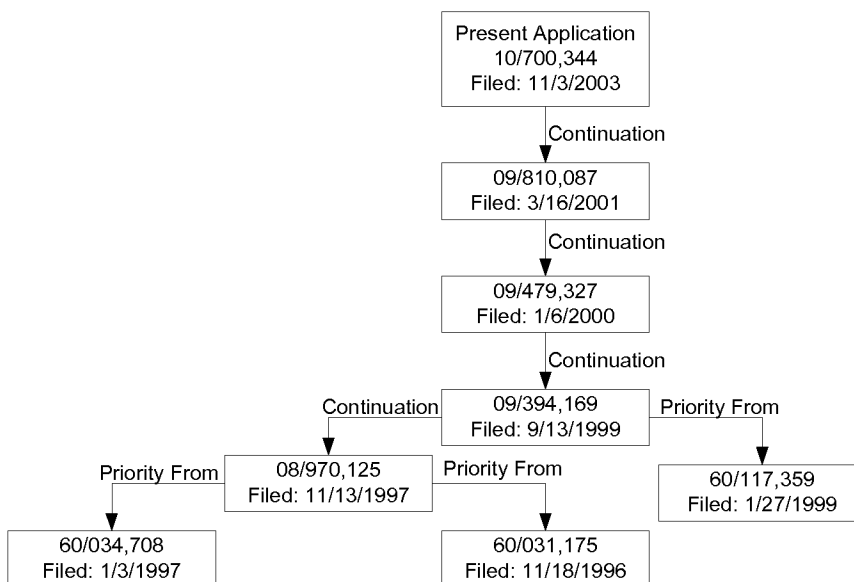


### **REMARKS**

Applicants appreciate the examiner's review of the prior art and request reconsideration of the pending claims in view of the following remarks. Applicants previously added claims 93-110, cancelled claims 1-36, 38, 39, 48, 50-62, 64, and 74-92, and amended claims 37, 63, 93, and 102. Accordingly, claims 37, 40-47, 49, 63, 65-73, and 93-110 are currently pending in the application.

### **Priority**

The Office Action suggests that the present application is not entitled to the benefit of provisional applications 60/031,175 and 60/034,708 because application 09/479,327 (from which the present application claims priority) was not filed within one year of the provisional applications. However, the present application and the 09/479,327 application also claim priority from U.S. Application number 09/394,169 which, in turn, claims priority from 08/970,125. The 08/970,125 application was filed within one year of the above mentioned provisional applications. Therefore, the priority of the present application is as follows:



Accordingly, the present application is entitled to a priority date of November 18, 1996 (the filing date of U.S. Provisional Application 60/031,175).

### **35 U.S.C. 102(a) Rejections**

The office action rejects claims 37, 40-47, 49, 63, 65-73, 93-110 under 35 USC 102(a) as being anticipated by WO 98/22178 (Cote, hereinafter “Cote”).

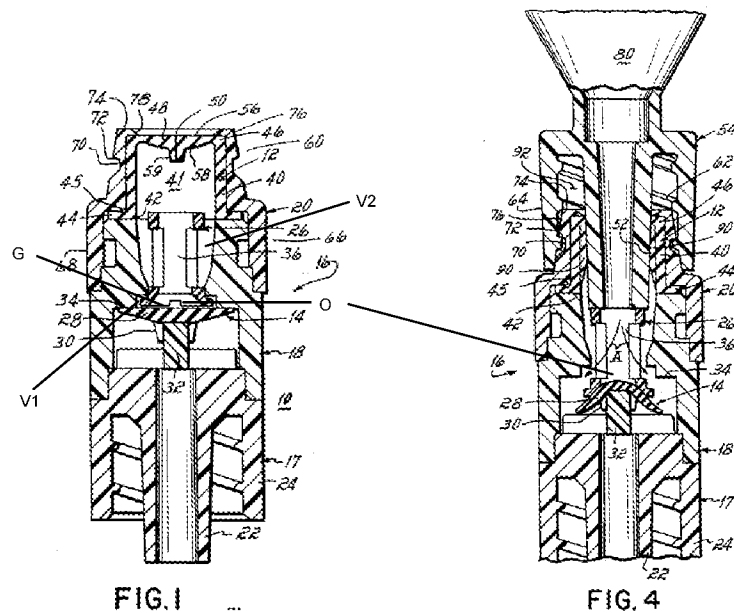
As mentioned above, the present application correctly claims priority to U.S. Provisional Applications 60/034,708 and 60/031,175 which have filing dates of January 3, 1997 and November 18, 1996, respectively. Therefore, the present application has a priority date of November 18, 1996 and Cote, which also claims priority from U.S. Provisional Applications 60/031,175 and 60/034,708, is not prior art. Accordingly, Applicants believe that this rejection is moot.

### **35 U.S.C. 103(a) Rejections**

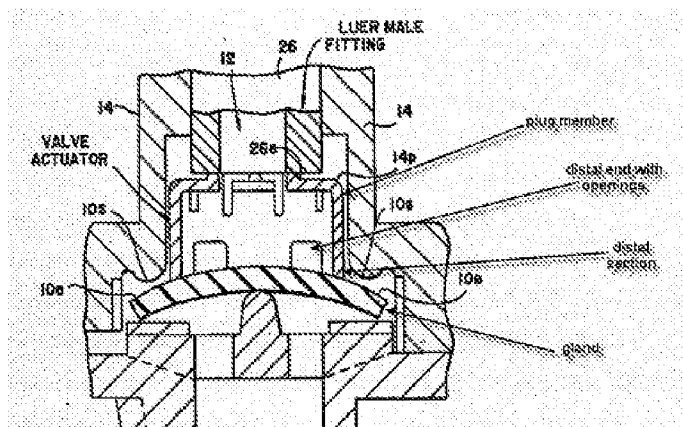
The office action rejects claims 37, 40-47, 49, 63, 65-73, 93-110 under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,578,059 (Patzner, hereinafter “Patzner”) in view of U.S. Patent No. 5,190,067 (Paradis et al., hereinafter “Paradis”).

Claim 37 defines, in relevant part, a medical valve having a housing, a plug member, and a substantially flexible, resilient gland member secured to the housing and the plug member. The plug member is a cannula, defines a channel for directing fluid through the valve, and has an opening nearer to its distal end. The gland member normally occludes the opening and contacts the distal section of the plug member (e.g., the portion of the plug member distal to the opening).

Patzner fails to teach such a valve. Rather, Patzner teaches an anti-reflux valve with an environmental barrier. In particular, Patzner’s valve has a series of connected housings (e.g., actuator housing 18, tapered thread housing 20, etc.), an actuator 26 and a disc valve 14. Patzner’s disc valve 14 includes a resilient disc 28 and an underside skirt 30 that connects to a nipple 32 on the housing (i.e., luer lock connector 17). In operation, a taper 52 of a male luer 54 impacts against actuator 26 moving it downwardly into disc 28, causing the disc 28 to deform over the nipple 32 and open the valve (col. 4, lines 45-55, Fig. 4). As discussed in Applicants’ response to the office action dated February 11, 2009 and as mentioned in the office action dated June 16, 2009, Patzner has a gap between the disc valve 14 and the actuator 26 (see Figures 1 and 4 reproduced below) and does not teach or suggest a resilient member that is secured to both a housing and a plug member.



Moreover, Paradis also fails to teach the deficiencies of Patzer. In particular, Paradis teaches a direction flow control device that has a diaphragm 10e, pre-biasing prongs 10p, and a plunger 14p (see Figure 1B as shown in the office action dated June 16, 2009 and reproduced below). In operation, as a luer male fitting is inserted into Paradis' control device, the plunger 14p moves downward causing the diaphragm 10e to move away from its seat 10s (i.e., become unseated). When the plunger 14p is moved upwards (e.g., when the luer is removed), the diaphragm reseats against seat 10s. When seated, the pre-biasing prongs apply a small force against the diaphragm 10e to properly seat the diaphragm 10e. (e.g., see Figure 1B reproduced below and column 6, lines 35-52). Nowhere does Paradis teach or suggest a resilient member that that is secured to both a housing and plug member.



The office action suggests that Paradis' plunger 14p constitutes a moveable plug and Paradis' diaphragm 10e constitutes the resilient member. The office action also suggests that there is no gap between the diaphragm 10e and the plunger 14p. Although Paradis mentions that the diaphragm is "held in position against" the plunger (column 8, line 16) and there does not appear to be a gap between them, Paradis does not teach or suggest that the diaphragm is secured to the plunger 14p, as required by claim 37. As known in the art, the term secure means attached and/or fastened. Paradis's diaphragm is not attached and/or fastened – at best it is simply in contact with or held against the plunger.

The office action appears to confuse contacting or being held against with being secured to. As the terms suggest, contacting or being "held against" merely requires contact between the diaphragm 10e and the plunger 14p. As mentioned above, the phrase "secured to" requires more – being attached/fastened in some manner – which Paradis does not teach or suggest. Applicants would also like to point out that Applicants' discussion of the gap between Patzer's disc valve 14 and actuator 26 (e.g., above and within Applicants' response to the office action dated February 11, 2009) was to point out that the disc valve 14 was not secured to the actuator 26 (e.g., if there is a gap between the components, the disc valve 14 cannot be secured to the actuator 26), not that the claim merely requires contact. Therefore, Patzer and Paradis fail to teach or suggest, alone or in combination a resilient member that is *secured to* both a housing and a plug member, as required by claim 37. Accordingly, claim 37 is allowable over the combination of Patzer and Paradis. Moreover, claims 40-47, and 49, which depend from claim 37 are allowable for at least the same reasons.

In a manner similar to claims 37, claims 63, 93, and 102 also define medical valves having resilient gland members that are secured to a housing and a plug member. Accordingly, claims 63, 93, and 102 are allowable over Patzer for the same reasons as discussed above with regard to claim 37. Moreover, claims 65-73, 94-101, and 103-110 which depend from claims 63, 93, and 102, are also allowable for at least the same reasons.

All pending claims therefore are allowable over the cited art. The application therefore is in condition for allowance and such action is earnestly solicited. Applicants do not believe that any extension of time is required. However, if an extension of time is required, Applicants hereby request that the associated fee and any additional fees required by this paper or credit any

overpayment to Deposit Account No. 19-4972. Applicants also request that the examiner contact applicant's attorney, Jonathan Lovely, if it will assist in processing this application through issuance.

Respectfully submitted,

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